

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed 24 May 2010.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 20, the phrase "a diameter in the range of about 25 mm to above" is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired as to the upper limit of the first portion shrouded wall diameter. See MPEP § 2173.05(b). For the purposes of examination, it has been assumed that the diameter upper range is about 27.0 mm as claimed in claim 13.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 13 and 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman (U.S. Patent 1,380,716).

7. Regarding claims 13 and 20-30, Herman discloses a handpiece used with flexible shaft assemblies, the handpiece comprises: a shrouded wall (A) having a first end (ungrooved portion on the left end in figure 1) and a second end (grooved portion on the right end in figure 1) which is adapted to receive the flexible shaft assembly (E), and the shrouded wall has a generally cylindrical shape; a chuck assembly (B/J/K) which is rotatably connected to the interior of the first end of the shrouded wall portion and protrudes out of the shrouded wall so that the jaws (J) of the chuck are able to receive a bit, a first portion (ungrooved portion) of the shrouded wall located at the first end has a diameter; and a second portion (grooved portion) of the shrouded wall located between the first end and the second end includes a plurality of grooves or ridges (portion A as seen in figure 1), the diameter of the second portion is less than the diameter of the first portion (at least in the insides of the grooved portions of the second portion have a diameter less than the first ungrooved portion as seen in figure 1), and wherein the chuck includes a plurality of jaws (j') which are able to secure a bit.

Herman does not disclose that a first portion of the shrouded wall located at the first end has a diameter in the range of about 25.5 mm to about 27.0 mm, a second portion of the shrouded wall has a diameter in the range of about 25.2 mm to about 25.6 mm, the chuck has an effective capacity up to 6.35 mm, wherein the length of the first portion is in the range of 35 mm to 45 mm, wherein the length of the first portion is 40 mm, wherein the diameter of the first portion is 26 mm, wherein the thickness of the

shrouded wall is in the range of 0.7 mm to 1.2 mm, wherein the thickness of the shrouded wall is 0.7 mm to 0.8 mm, wherein the second portion has a length in the range of 40 mm to about 85 mm, wherein the second portion has a length of 62 mm, wherein the second portion has a diameter of 25.4 mm. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to have selected whatever sizes were desired for the shroud and chuck for the purpose of matching the shroud size to the desired handpiece size and for retaining a desired range of bits, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges or values involves only routine skill in the art.

Response to Arguments

8. Applicant's arguments filed 24 May 2010 have been fully considered but they are not persuasive.
9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Applicant's invention includes a novel handpiece apparatus used for cutting tools which is able to accept all standard shank sizes from at least 1/16 to ~ inch", "the present invention provides a shrouded/guarded adjustable 3 jaw key type chuck", and "the handpiece disclosed in Herman does not relate to the Jacob chuck as is disclosed in the present invention") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. In response to applicant's argument that the Herman patent fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "there are no dimensions given in the Herman patent. The configuration and dimensions in applicant's invention are drastically different than in the Herman patent. For example, Herman fails to disclose or render obvious wherein the diameter of the second portion is less than the diameter of the first portion where in the first and second portion have a novel range in diameter, which allows for various sized chucks to be received.") are not rejected using the Herman patent, but are instead rejected using the 35 U.S.C. 103(a) obviousness rejection as set forth above.

11. For the reasons as set forth above, the rejections are maintained.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. GATES whose telephone number is (571)272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric A. Gates/
Primary Examiner, Art Unit 3726
7 June 2010